

No. 11,445

United States
Circuit Court of Appeals
For the Ninth Circuit

STUART OXYGEN Co., LTD.,

Appellant,

vs.

WILLIAM JOSEPHIAN,

Appellee.

Reply Brief for Appellant

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INTRODUCTION

Nothing appears in the Brief for Appellee which can be taken to rebut the showing made in the Brief on Behalf of Appellant. The points raised by appellee require only short discussion to demonstrate their invalidity.

THE PATENTED DEVICE IS A MINOR IMPROVEMENT

The claims, and not the stated objects of the invention quoted at page 2 of the Brief for Appellee, define the invention.

Furthermore, Josephian testified that he was not the first to obtain the stated objects of his invention, saying (I, 66-67) :

"Q. Your patent states a number of objects of your invention and as I read this particular passage I would like you to consider it with the purpose of telling me whether or not you regard yourself as the first to accomplish these objects. Beginning at Page 1, Column 1, Line 5, you say:

'Among the objects of my invention are: to provide a simple and efficient truck for handling a plurality of cylinders; to provide a means for easily handling a plurality of heavy cylinders containing a usable gas; to provide a means for assembling a plurality of cylinders into an easily movable unit, and to provide a simple and efficient truck for handling gas cylinders, such as oxygen, hydrogen, acetylene, carbon dioxide tanks, or the like'. Did you consider that you were the first to accomplish any or all of those objects?

A. About providing an easy and efficient means, yes, I feel that I was the first to accomplish that effect, but as far as accomplishing portability is concerned, no. As I said before, there were others that had manifolded cylinders.

Q. You mean yours was comparatively more easy and comparatively more efficient than previous things— A. Yes."

Under such circumstances the fact that defendant's device lacks the "second stable position" of the claims, and lacks the advantages of a structure having such a second stable position, as explained at pages 20 to 22 of the Brief for Appellant, is of great importance.

FAILURE OF THE PATENT OFFICE TO FIND THE NEAREST PRIOR ART WEAKENS RATHER THAN STRENGTHENS THE PATENT.

Plaintiff argues at page 5 of the Brief for Appellee that the allowance of the claims in suit, without citation of art, was a "recognition" of some merit in the patentee's device.

No authority is cited for such a proposition and all of the authority is to the contrary where, as here, it is clear that the Patent Office either overlooked or did not know of the nearest prior art.

The devices illustrated in Defendant's Exhibits A-1 and A-2 (II, 231-232); B-1 to B-4 (II, 234-237); and C-1 to C-4 (II, 238-241), manifestly were not before the Patent Office when plaintiff's patent was granted.

Under such circumstances it is well settled that any presumption which would otherwise attend the issuance of the patent is weakened by the circumstance that closely similar prior references, such as Defendant's Exhibits B-1 to B-4 (II, 234-237) in particular, were not interposed or considered by the Patent Office during the prosecution of the Josephian application. *Walker on Patents (Deller's Edition)*, Section 701, page 2010.

The logic of this rule is forcefully stated, in terms clearly applicable to the present case in:

American Soda Fountain Co. v. Sample, 130 Fed. 145, 149 (C.C.A. 3).

"We do not agree with the contention that the file wrapper discloses the patent to have been granted as first applied for, without any references, adds any force to the presumption of novelty arising from

the grant. On the contrary we think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the 'Clark' patents. It does not seem likely that an expert examiner would pass them by, without notice or consideration, if they had been called to his attention."

This case was cited with approval and quoted at length by this Court in:

Stoody v. Mills Alloys, Inc., et al., 67 Fed. (2d) 807, 810 (C.C.A. 9).

Defendant's purported admission of validity quoted out of context at page 6 of the Brief for Appellee loses all force as a "tribute" when viewed in its context, as follows (I, 170):

"Mr. Lassagne: It would be skill in the art to put a bump on the bottom of the Western Steel device so you can wrestle it around more.

The Court: But with this last clause in it you do not claim that it is not an invention?

Mr. Lassagne: With the last clause in it, it is plainly not infringed. I think I can show you that.

The Court: No, with the last clause in it, is it invention?

Mr. Lassagne: We do not contest whether it is invention or not. I would be willing to admit that for the purpose of this case.

The Court: You say if that last clause was left off you would contest it; you would say it does not consist of invention?

Mr. Lassagne: It does not involve any invention whatsoever over the Western Pipe and Steel device, which it is admitted to have been in the prior art."

DEFENDANT'S CONSIDERATION OF PLAINTIFF'S PATENT AND COMMERCIAL DEVICES WAS GIVEN UNDUE WEIGHT BY THE TRIAL COURT.

The fact that defendant studied the plaintiff's patent and his commercial device before building a device used for a similar purpose is brought forward at page 6 of the Brief for Appellee, apparently as evidence of intent on the part of defendant to appropriate plaintiff's purported invention.

That this contention influenced the trial court is made plain by the comment of the Court (I, 175) that "the defendant knew about plaintiff's patent and what he was using it for."

Far from being evidence of any intent to appropriate anything covered by the patent in suit, such facts are clear evidence of respect for plaintiff's ostensible patent rights, whether or not the patent be valid.

The Circuit Court of Appeals for the Seventh Circuit has made clear that no inference adverse to defendant can be drawn from such conduct, saying in:

Atkins, et al. v. Gordon, 86 Fed. (2d) 595, 596 (C.C.A. 7):

"One may legitimately study the patent and microscopically examine the language of the claim in order to make a product which will serve the same purpose and yet avoid infringement of the patent. Such a right is the logical, beneficial result which was sought through the adoption of the comprehensive patent system of our government.

* * * * *

"Appellants were not barred from making ear muffs simply because appellee acquired a patent on a certain kind of ear muff. *They were at liberty*

to examine appellee's ear muffs and his patent to ascertain its length and breadth. Likewise they could examine the prior art to ascertain what range of equivalents should be given to the various elements set forth in the claim. If they could make ear muffs without utilizing one of the elements of the claim, they were perfectly free to do so. *Whether it was done deliberately or accidentally, with the patent before them or otherwise is quite immaterial.* The question is, Did their ear muffs infringe the claim in question?" (Emphasis supplied.)

A "STABLE POSITION" AS DEFINED IN THE PATENT IN SUIT IS NECESSARILY A POSITION OF REST

The Brief for Appellee goes to great lengths in attempting to avoid the effect of the definition of a "stable position" contained in the specification of the patent in suit. It is submitted that the Record does not support the statements made in appellee's brief on this subject.

At page 9, the Brief for Appellee says "the defendant's own expert directly admitted that stable did not mean immovable but that it is a relative term"; citing page 146 of the Record. There we find Mr. Doble, speaking of an artillery shell in flight, saying:

"A. Certainly (it is more stable than it would be without the rifling), but *it is not stable* in any sense of the word;".

Again at page 18, the Brief for Appellee says "defendant, through its expert, admitted that its depression or ring was equivalent to the Josephian ring" citing page 126 of the Record. There we find Mr. Doble saying exactly the opposite:

"Q. If the ring that is on the defendant's device were widened so that the proportion would be the same, as in the case of plaintiff's device, it would result in the center of gravity that would enable it to have the secondary position of plaintiff's device?

A. That is the point. It takes a minor change in the structure to bring about that advantageous feature, which is the claimed feature, and which is the essence of that patent all the way through."

CONCLUSION

It is submitted that the reasons for reversal of the decision of the District Court which were advanced in the Brief on Behalf of Appellant remain valid and such action is respectfully urged.

Respectfully submitted,

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Dated at San Francisco, California, April 23, 1947.

